

Serial No. 10/647,013

REMARKS

The applicants have amended certain descriptions in the Specification and the Claim with the objective of presenting a full, clear and complete description of the cultivar in order to comply with 37 CFR 1.163 and 35 U.S.C. 112 and to overcome the objections listed in the Office Action dated 01/16/2004. Specifically:

In response to the objections set forth in paragraph A of the Office Action, the Specification has been amended to correct disclosure of the precise year (1995) the breeders have made their selection of the claimed plant from the seedlings which were progeny of the hybridization in 1994.

In response to the objections set forth in paragraph B of the Office Action, the Specification has been amended to correct the reference to the seed parent 'Pouldiram'. Page 2 of the original application incorrectly stated that 'Pouldiram' was the pollen parent.

In response to the objections set forth in paragraph C of the Office Action, the Specification has been amended to provide more descriptive botanical terms which describe the flower buds of the claimed plant.

At this time, Applicants are not able to respond to the objections set forth in paragraph D of the Office Action for the following reasons. The applicants do not have a botanical description for the seed on file at this time. Additionally, there are no seeds to observe on plants this time of the year. Applicants will make a description of the seed as soon as this information becomes available and issue a supplemental amendment.

In response to the objections set forth in paragraph E of the Office Action, the Specification has been amended to provide additional botanical descriptive data referring to the leaflet dimensions on leaves of the claimed plant.

Additional amendments have been made to page 4, where Applicants have more accurately described the circumstances under which the observed plants have been cultivated.

In response to the Examiner's rejection based on 35 USC § 102(b), dated 01/16/2004, the applicants respectfully submit the following statement:

In the Office Communication, under the heading 35 U.S.C. 102, the Communication states:

"The published grants and applications are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226; 210 USPQ 790, 794 (CCPA 1981). See also MPEP section 2128.

For example, every two months the CPVO publishes an Official Gazette containing all the information appearing in its Registers, in particular applications for protection, proposals for variety denomination and grants of title. Any other information the CPVO feels the public should be informed about may also be published in the Gazette.

A printed publication can serve as a statutory bar under 35 U.S.C. 102 (b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. In *re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain

them and make/reproduce the Siokora cultivar disclosed in the cited publications").

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the published application, proposed denomination or granted PBR certificate, combined with the knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant.

The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office's collection of retail catalogs has revealed no evidence that the claimed plant on sale anywhere in the world more than one year prior to the filing date of the instant application. However, the Office's collection of retail catalogs is not comprehensive.

Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties, free of charge. Since the inventor and the assignee of the instant application are in the better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information per the attached Requirement for Information Under 37 CFR 1.105."

The Applicants respectfully challenge the position and policy stated in the Office Communication that the foreign published PBR Applications and Grants enabling disclosures under 35 U.S.C.102 (b) for the following reasons:

1. 102(b) is not applicable to Plant Patent Applications as it is to Utility Patent Applications.
  - a. Foreign Commercial or Public Use is Not a Bar to Patentability Under 35 U.S.C. 102(b).

Prior to the Patent Act of 1897, any public use or sale of an invention for more than two years prior to the date of application for a patent was a bar to patentability. In 1892, the U.S. Supreme Court, in the landmark case of Gandy et al. v. Main Belting Co., et al., 143 U.S. 587, 12 S.Ct. 598 (US 1892), concluded that Congress only intended that public use or sale of an invention in the United States could affect the patentability of that invention in the United States.

The Gandy case involved a U.S. patent for a canvas belt used to drive pulleys in machinery. The new canvas belt was unique in that the warp threads were stouter than the weft threads. The defendant argued that the invention had been in use in England more than 2 years prior to the U.S. filing date. The Gandy court states:

... There is no direct testimony to show whether this canvas was made up into belting, or when the belts were first publicly used or sold abroad; indeed, nothing to show it was in public use or on sale before the application for the patent in this suit was filed. Even if we were authorized to presume that such canvas was manufactured into belting and sold or used in England, there is not a particle of testimony tending to show that it was publicly used or put on sale in this country. Conceding that there was sufficient evidence of the use of such belting in England, we think this does not vitiate the patent.

Gandy et al. v. Main Belting Co., et al., 143 U.S. at 592, 12 S.Ct. at 600.  
[Emphasis added.]

After a careful analysis of the relevant statutes, the Gandy court concluded that public use or sales activity outside of the United States should not be considered in determining the patentability of inventions in the United States:

... we think it was manifestly the intention of congress that the right of the

patentee to his invention should not be denied by reason of the fact that he had made use of it, or put it on sale abroad, more than two years before the application, provided it were not so used or sold in this country.

Gandy et al. v. Main Belting Co., et al., 143 U.S. at 593, 12 S.Ct. At 600.  
[Emphasis added.].

The Patent Act of 1897 codified the Gandy decision by expressly adding the requirement that public or on sale activity must occur within the United States to bar patentability. According to the 1897 act, a patentable invention must not be:

. . . patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned.

Act of March 3, 1897, ch. 391, Sec. 1, 29 Stat. 692.

No change to the law or interpretation by the courts since the 1897 Patent Act has modified the clear intent of the Congress on this point: Foreign public or commercial use is not a barring activity under 35 U.S.C. 102(b)<sup>1</sup> Public availability or on-sale activity of the invention or plant in a foreign country is not a factor in determining patentability under 35 U.S.C. 102(b).

In re LeGrice, 133 USPQ 365 (CCPA 1962), demonstrates the application of this fundamental principle to plant patents. The LeGrice court discusses Section 102(b), stating:

. . .The underlying concept on which the courts permitted such a bar is that the description of the invention in the printed publication was sufficient to give possession of the invention to the public.

In re LeGrice, 133 USPQ, 301 F.2d at 931.

In the LeGrice case, the USPTO rejected two plant patent applications for rose varieties under Section 102(b), on the ground that both varieties had been described in printed publications in England more than one year prior to the U.S. filing dates. The court describes the publications as follows:

. . . The publications occur in the National Rose Society Annual of England and in catalogues. The annual describes appellant as having raised the roses described and the catalogues show color pictures of these roses. There is no dispute that the publications relate to and picture the identical roses which were originated by appellant and he now seeks to patent.

In re LeGrice, 133 USPQ, 301 F.2d at 930.

Under these facts, the LeGrice court was clearly presented with evidence not only of printed publications, but also of foreign public use of the rose varieties, taking into consideration the following points:

1. The Dusky Maiden rose is identified as receiving the Gold Medal Award in 1949, which indicates that it was inspected and evaluated by one or more rose experts, other than the breeder, to merit such an award. This is public use.
2. The Charming Maid is described as receiving an award titled "Gold Medal Provincial Show, 1953," which indicates that the variety was displayed at a "show" attended by the public, including at a minimum the rose experts who conferred the Gold Medal upon this variety. This is public use.

3. The breeder himself admits that both the Dusky Maiden and the Charming Maid rose varieties were displayed in "catalogues" more than one year prior to the U.S. filing date. The word "catalogue" has not changed much in the last 100 years, and it is commonly used to describe a list of products for sale. Display of the roses in "catalogues" indicates that both roses were offered for sale at the time the catalogues were published.<sup>2</sup> This is public use.

How does the LeGrice court treat such clear evidence of public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date? Quite simply, the LeGrice court disregards the evidence as immaterial to its analysis of the 102(b) rejection based upon printed publications. This approach is completely consistent with America's underlying philosophy regarding barring prior art - first enunciated in *Gandy* - if the reference does not make the invention available to the American public, then it cannot bar the patenting of the invention in America.

The LeGrice court summarizes the issues under consideration as follows:

Resolution of the issue on these appeals requires us to determine whether as a matter of law, the English publications constitute, within the meaning of 35 U.S.C. 102(b), a bar to appellant's right to patents on said applications.

The applicable portion of 35 U.S.C. 102(b) reads:

'A person shall be entitled to a patent unless – \* \* \* (b) the invention was \* \* \* described in a printed publication \* \* \* more than one year prior to the date of the application for patent in the United States, \* \* \*.'

In re LeGrice, 133 USPQ 365.

In reciting the pertinent parts of Section 102(b), the LeGrice court skipped over - deleted - the

words "public use or sale in this country" - in the clear face of evidence of public use and sales of the rose varieties in England more than one year prior to the U.S. filing date. The LeGrice court goes on to determine the meaning of the term "printed publication," but at no point does the court discuss the impact of any public or on-sale activity that has occurred. Applicant submits that the LeGrice court recognized that public or on-sale activity occurring in a foreign country is clearly irrelevant to a determination of patentability under 35 U.S.C. 102(b). The possibility of foreign public or on-sale activity, even when coupled with a description of the plant varieties in printed publications, did not even bear mentioning by the LeGrice court, let alone considering.

Allied Colloids Inc. v. American Cyanamid, 64 F.3d 1570 (Fed. Cir. 1995), provides another example of the Federal Circuit setting forth the facts which constitute a foreign commercial or public use, and then treating those facts as immaterial to its 102(b) legal analysis. In Allied Colloids, the court considers the validity under 35 U.S.C. 102(b) of a patented process which had been the subject of testing in England and the U.S. prior to the filing of a U.S. patent application:

... At Colloids' invitation samples of Detroit sludge were sent to England for testing. After some favorable test results in England, about twenty samples of Colloids' sewage treatment materials were brought to Detroit for testing on fresh Detroit sewage. These samples were about two to four ounces in size. They were tested on April 16-17, 1985, in a laboratory located at a Detroit sewage treatment plant. The tests showed promising results for some of Colloids' products. Additional laboratory tests were conducted in Detroit in July 1985, and plant scale trials were conducted in Detroit in December 1985. Colloids' patent application was filed in the United States on April 23, 1986; thus only the first series of tests is relevant to the asserted public use bar, i.e. the April 16-17, 1985 tests.

Id. at 1573.

The Allied Colloids court treated as immaterial the tests which were done in England, as that



foreign public use is not a factor in determining patentability under 35 U.S.C. 102(b) because it did not occur in this country. Once again, the foreign activity was immaterial because it did not make the invention available to the American public.

The statute and legislative history on this point is crystal clear: The possibility, or even conclusive proof, of commercial or public use of the claimed variety of the present invention in a foreign country is not relevant to the determination of "plant patentability" under 35 U.S.C. 102(b).

**b. The Description in a Printed Publication must be Enabling to the American public to Bar Patentability under 35 U.S.C. 102(b).**

Under 35 U.S.C. 102(b), an invention is not patentable if it was described in a printed publication, in this or a foreign country, more than a year prior to the filing date of the U.S. application. In order for a printed publication to serve as a reference under 35 U.S.C. 102(b), it must enable the invention. In *re* Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985)("Even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling."); In *re* Paulsen, 30 F.3d 1475, 1478 (Fed. Cir. 1994)("A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. . . In addition, the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention."); *Advanced Display Systems Inc., v. Kent State University*, 54 USPQ2d 1673, 1679 (Fed. Cir. 2000)(" . . .invalidity by anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation."). See also *In re LeGrice*, 133 USPQ 365 (CCPA 1962); *Helifix Limited v. Block-Loc, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000), *In re Sasse*, 629 F.2d 675 (CCPA 1980), *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) citing *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983).

A written description of a plant variety is simply not enabling. Plant patents have always been

exempt from the Section 112 written enablement requirement which applies to all utility patents - in recognition that a particular plant simply cannot be made by reference only to a printed publication. Congress acknowledged this concept when the Plant Patent Act of 1930 was drafted. See *In re Bergy*, 596 F.2d 952, 984 (CCPA 1979)(discussing the inclusion of the language which is now 35 U.S.C. 162: "Under existing law, it was not seen how a plant could be described in a written document so as to comply with the written description requirement pertaining to "utility" patents.")

The court in *In re LeGrice* confirmed this point:

. . .The proper test of a description in a publication as a bar to a patent as the clause in used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought. Unless this condition prevails, the description in the printed publication is inadequate as a statutory bar to patentability under section 102(b).

*In re LeGrice*, 49 CCPA 1124 at 1138.

The *LeGrice* court discussed the permissibility of combining the "description of the invention in the printed publication" with "knowledge of the particular art" to achieve the invention on which a patent is sought:

The mere description of the plant is not necessarily an 'enabling' disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possessions of those so skilled.

\* \* \*

. . . While the present knowledge of plant genetics may mean as a practical matter, that the descriptions in such general publications as are here involved cannot be relied upon as a statutory bar under section 102(b), we must be mindful of the scientific efforts which are daily adding to the store of knowledge in the fields of plant heredity and plant eugenics which one skilled in this art will be presumed to possess.

In re LeGrice, 133 USPQ 365

In order for a printed publication to be a 102(b) reference, it must be an enabling reference. A printed reference is enabling if a reader of the publication possessing ordinary skill in the art would be able to make and use the invention described without undue experimentation. Propagation of new varieties of roses has been increasingly technical, requiring (H.I.D.) High Intensity Discharge Lighting systems supplying a minimum of 80 watts output/square meter of greenhouse for a minimum of 22 hours per day, fog propagation systems, computer controlled temperature, computer controlled fertilizer injection of nutrients, and ultra-violet pasteurization of all irrigation water used in propagation. The hybridizer requires that anyone propagating and growing the variety utilizes the aforementioned facilities. The hybridizer supplies propagators with detailed information concerning propagation and growing techniques for the variety. The documents being referred to by the Examiner shed no light on the requirements for propagation of the variety. A person skilled in the art would not have access to plant material of the variety, since the variety was under US quarantine until June, 1999.

Herein lies the fundamental distinction which sets plant patents apart from utility patents: A plant patent only confers protection on the plant which was invented (not a plant with the same characteristics), and its asexual progeny. See *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1566 (Fed. Cir. 1995). A written description of a plant variety may be capable of directing a breeder to independently create a new plant variety having the characteristics of the described plant. However, the newly created

plant would not infringe the described plant, because it was not asexually produced from the germplasm of the described plant.

Technology does currently exist which would allow a reader of a printed document to make a clone of a particular plant without access to the plant material itself, even in the simplest of plant species, let alone the Rosa species. Therefore, a printed publication which is available to the American public without corresponding availability of the actual plant material does not, and cannot, at the current level of technology, make the described plant available to the American public.

## 2. In re Legrice and Imazio Govern the Application of 102(b) to Plant Patents, Not ex Parte Thomson.

Ex parte Thomson, 24 USPQ2d 1618, 1620 (BPAI 1992) involved utility patent protection for a sexually propagated cotton plant. Both In Re LeGrice, 133 USPQ 365, 301 F.2d 929(CCPA 1962); and Imazio Nursery, Inc. v. Dania Greenhouses, 69 F.3d 1560, 1566 (Fed. Cir. 1995) involved plant patent protection for asexually propagated plants. There are fundamental differences between utility patents and plant patents, and between sexually propagated plant varieties and asexually propagated plant varieties. These differences dictate that Ex Parte Thomson does not, and cannot, control the application of 102(b) to plant patents.

For many years there was considerable debate in the courts about the scope of claim protection for plant patents. The question was whether the single claim of a plant patent covered "a plant" matching the botanical description in the patent specification, or only "the plant" which was the subject of the patent and that plant's asexual progeny. This debate was resolved conclusively in 1995 by the Federal Circuit in the Imazio case. The Imazio court states:

It is clear from the legislative history that as a result of the asexual reproduction requirement, only a single plant, i.e., reproduction from one original specimen in the words of Congress, is protected by a plant patent. At the time of enactment, Congress recognized that the asexual reproduction prerequisite greatly narrowed the

scope of protection of plant patents but found such a limitation necessary to ensure that the characteristics of the plant to be patented were maintained.

\* \* \*

In view of the statutory language, the legislative history, the case law, the views of the commentators, and a review of relevant provisions of the PVPA, we conclude that the scope of a plant patent is the asexual progeny of the patented plant variety. Variety as used in section 161 encompasses a single plant, the plant shown and described in the specification.

Imazio Nursery, Inc. v. Dania Greenhouses, 69 F.3d at 1566 and 1568.

Having resolved the issue of the scope of protection of a plant patent, the Imazio court then considered the elements required to establish infringement of a plant patent, and the defenses to an allegation of infringement. Essentially, there is a single element:

We must construe the term asexual reproduction in section 163 in the same way as we did in section 161. Thus, for purposes of plant patent infringement, the patentee must prove that the alleged infringing plant is an asexual reproduction, that is, that it is the progeny of the patented plant.

Imazio Nursery, Inc. v. Dania Greenhouses, 69 F.3d at 1569.

From a practical standpoint, this requirement means that the patentee must prove that the infringer had physical access to the patented plant or its progeny. The asexual reproduction requirement of plant patent infringement also means that plant patents are subject to a unique defense in the patent world - independent creation. The Imazio court explains:

. . . The statute requires asexual reproduction of the patented plant for there to be infringement. It is necessarily a defense to plant patent infringement that the alleged infringing plant is not an asexual reproduction of the patented plant. Part of this proof could be, thus, that the defendant independently developed the allegedly infringing plant. However, the sine qua non is asexual reproduction. That is what the patentee must prove and what the defendant will seek to disprove.

Imazio Nursery, Inc. v. Dania Greenhouses, 69 F.3d at 1570.

The Plant Patent Act itself also notes a significant difference between plant and patents and utility patents. Title 35 USC Section 162 provides:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonable possible.

The legislative history of Section 162 makes it perfectly clear that Congress knew that it was not possible to enable a plant patent by a mere written specification, and so relaxed the Section 112 requirements for that reason.

Ex parte Thomson involved an application for a utility patent, in which the claimed invention was "a plant" having the described features. Claims 1 and 2 are illustrative:

1. A cotton cultivar having the designation Siokra (ATCC 40405).
2. Seeds of the cotton cultivar according to Claim 1.

Ex parte Thomson at page 1619.

The scope of a utility patent claim encompasses any device having the characteristics described in the claim, as supported by the specification. In the case of a utility claim for a plant variety, the claim encompasses "any plant" having the described characteristics, regardless of origin. More than one claim is permissible in a utility patent.

Utility patents are clearly very different from plant patents. First, the scope of a claim in a utility patent covers "a plant" matching the plant described in the specification. Second, Section 112 applies with full force to utility patents. Third, there is no requirement to prove direct access to the patented object or technology in order to prove infringement of a utility patent claim. And fourth, independent creation is absolutely not a defense to an allegation of utility patent infringement.

These differences carry through to the examination strategy which must be employed to properly examine a plant patent application. The unique and very narrow scope of protection offered by a plant patent has a direct impact on the scope of prior art which can be properly considered in determining the patentability of a new plant variety. Because a plant patent cannot be infringed without direct access to the new plant or its asexual progeny, it is the applicant's position that a new plant variety cannot be anticipated without direct access to the American public in the United States of the new plant or its asexual progeny.

To illustrate applicant's position that "a plant patent cannot be anticipated without direct access to the new plant," consider the following scenario: A hypothetical one thousand page treatise about a new plant variety has been published. The treatise is devoted to a description of the plant invention of the present application in excruciating detail. Now suppose that all propagatable plant material for the variety dies. What happens to the invention? It ceases to exist, regardless of the existence of the treatise. The treatise is a bar to patentability under 35 U.S.C. 102(b) only if it contains within its pages the information required to "resurrect" the invention. No matter how skilled or knowledgeable, a worker in the art of plant breeding could not "resurrect" the variety from the printed page without propagatable plant material to work with. Therefore, the treatise is not prior art under 35 U.S.C. 102(b) because it does not put the invention in the possession of the public. A Plant Breeder's Right Certificate provides far less descriptive information than would the hypothetical one thousand page treatise, and clearly is not prior art under 35 U.S.C. 102(b).

In the case of a plant patent, propagatable material of the new variety is not only essential to enable the invention - it is the invention. In the absence of propagatable material, the variety does not exist, nor can it be conjured up from the description in any printed publication, regardless of how

detailed or specific. So, in the absence of any publicly available asexually propagatable plant material in the United States, no plant variety can, at the present level of technology, be anticipated by a mere printed publication, regardless of how detailed it is, and regardless of where it is published. Foreign asexually propagatable plant material, unlike the information in a printed publication, is not freely accessible to the American public. The quarantine laws of the United States strictly prohibit the importation of all asexually propagatable rose plant material unless that material goes through a U.S. Department of Agriculture approved quarantine facility. The variety descriptions and current status of plant material in the U.S. quarantine program are public information, but the plant material itself is not available to any member of the American public other than the importing person, and then only after the quarantine procedures have been completed.

The court in *In re LeGrice* established a perfectly workable and rational approach for applying the policy and the language of 102(b) to this unique situation. The *In re LeGrice* case was concerned with whether or not foreign plant varieties are actually available to the American public, and acknowledged that at some future point in time, a mere printed publication might enable a person to make an genetic duplicate, or clone, of a particular plant without access to the plant material itself. The Applicant does not believe that day is here yet. The holding of *In Re LeGrice* is thus applicable to, and controlling, in the present case

Additionally, "*Ex parte Thomson*", an internal Board of Patent Appeals and Interferences decision, concerning a utility patent application for a sexually propagated cotton variety; cannot overturn "*In re LeGrice*", which is a decision of the U.S. Court of Customs and Patent Appeals. The decision of the court must be the controlling law when compared to an internal decision of an Administrative Agency.

3. "*Ex parte Thomson*", an internal Board of Patent Appeals and Interferences decision cannot overturn "*In re LeGrice*", which is a decision of the U.S. Court of Customs and Patent Appeals.



"Ex parte Thomson", an internal Board of Patent Appeals and Interferences decision, in an internal Patent and Trademark Office ruling concerning a utility patent application for a sexually propagated cotton variety; cannot overturn "In re LeGrice", which is a decision of the United States Court of Customs and Patent Appeals that dealt specifically with an asexually propagated rose variety. An internal Board of a Federal Agency cannot overturn the decision of a Federal Court of Appeals, as is the U.S. Court of Customs and Patent Appeals.

4. The Facts of the Present Case Are Materially Distinguishable from the Facts of ex Parte Thomson.

For the sake of argument, the Applicant will suppose for a moment that the Board's holding in Thomson is controlling in the present case. The Thomson Board concluded, as noted above, that a published description of Siokra cotton was a bar to patentability under 35 U.S.C. 102(b), because Siokra seeds were presumably available to the skilled worker. In the Office Communication, it is argued that the cited Plant Breeder's Rights Applications and Certificates are a bar to patentability of the claimed new variety under 35 U.S.C. 102(b), because propagatable material of the variety is presumably available to the skilled worker. The Applicant respectfully contests the argument. First, as emphasized above, Plant Breeder's Rights Applications and Certificates fail as references under 35 U.S.C. 102(b) for lack of enablement. Second, propagatable material is not available to the skilled worker in the United States.

The new plant variety of the present application originated in Denmark. U.S. laws prohibit the direct importation and use of the variety into the United States, unless the variety has first been subjected to and passed the USDA quarantine and screening regimen. The claimed variety is not generally available to any person, skilled or otherwise, in the United States due to the prohibition of direct importation and use of the plant material of the genus *Rosa* by the Plant Protection and Quarantine Regulations overseen by the Animal and Plant Health Inspection Service of the U.S. Department of Agriculture. Prior to and after release from quarantine, the variety was grown in a

locked test nursery controlled by the Applicant, with the objective of completing the quarantine process and confirming the compatibility of the variety with U.S. growing conditions. No other person in the United States had access to the variety.

In the United States, a skilled worker cannot combine the description of the new variety in the cited foreign Plant Breeder's Rights Applications and Certificates with propagatable plant material, because propagatable plant material is not available in this country due to quarantine restrictions. An important distinction must be made here between the plant material required to reproduce the present variety, and the seeds required to reproduce Thomson's Siokra cotton variety, which was the subject of a utility patent application. As discussed in detail herein, plant material for prohibited varieties (including the present invention) must go through USDA quarantine before the material is accessible to any person in the United States. The quarantine process takes two full growing seasons. In contrast, cotton seed may be admitted into the United States after fumigation and inspection, a process which can take as little as a few days. See 7 C.F.R. 319.8 et seq. (1999).

As discussed above, the public policy favoring ". . . prompt and widespread disclosure of inventions to the public," *Western Marine Electronics, Inc. v. Furuno Electric Co., Ltd.*, 764 F.2d 840 (Fed. Cir. 1985), refers to disclosure of inventions to the American public. Disclosure of inventions in a way that does not benefit the American public does not fulfill the Constitutional mandate to "promote science and the useful arts." Constitution of the United States of America , Article I, Section 8.

Furthermore, the prohibition against patenting set forth in 35 U.S.C. 102(b) is intended, in part, to "protect the public in the prior use of an invention," or in other words to avoid the granting of a monopoly. A monopoly is "the exercise of an exclusive privilege granted to anyone for the sole buying, selling, making, working, or using anything which the public had before the exclusive privilege was granted. . . a monopolist is one who by reason of this exclusive privilege takes something from the public which they had a right to use before the grant of such exclusive privilege." Ernest B. Lipscomb III, *Lipscomb's Walker on Patents* (The Lawyer's Cooperative Publishing Co. 1985), section 1:6 at 39.

In the present case, the American public had no right, or reasonable expectation of a right, to propagate the claimed variety prior to the filing of the plant patent application. The variety was under

the control of the foreign owner, who had not released the variety to the United States. It was not until a testing agreement was reached with a U.S. grower that the owner of the variety was willing to make the variety available in this country. No other entity in the United States has had access to the plant material in the United States until 11 months prior to the application for Plant Patent.

For the foregoing reasons, the Applicant asserts that the cited Plant Breeder's Rights Certificates are not a bar to patentability of the claimed new variety under 35 U.S.C. 102(b), because propagatable material of the variety is not available to the skilled worker in the United States.

In summary, the Applicants respectfully challenge the Examiner's position as outlined in the 01/16/2004 Office Communication as being a substantive policy change without appropriate procedures under USC Title 5, Administrative Procedures Regulations; and other Federal rules and regulations which prohibit retroactive actions as outlined herein.

For all the reasons listed above, the applicants respectfully submit that the errors in the Specification are corrected, and that the claims comply with Section 112. The application is believed to be in condition for allowance, and notice thereof is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ken Ryneerson', is written over a horizontal line. The signature is stylized with a large loop and a long horizontal stroke extending to the right.

Ken Ryneerson  
Poulsen Roser Pacific, Inc.